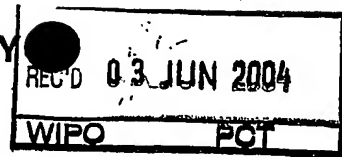




INTERNATIONAL PRELIMINARY EXAMINATION REPORT
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference TP101867/SAV	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/FI 03/00182	International filing date (day/month/year) 11.03.2003	Priority date (day/month/year) 14.03.2002
International Patent Classification (IPC) or both national classification and IPC B05D1/06		
Applicant METSO PAPER, INC. et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.
- ☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
- These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 10.10.2003	Date of completion of this report 02.06.2004
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer de Biasio, A Telephone No. +49 89 2399-8627 

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International application No. **PCT/FI 03/00182**

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-22 as originally filed

Claims, Numbers

1-20 as originally filed

Drawings, Sheets

1/1 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

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5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	8-10,13,16,18-20
	No: Claims	1-7,11,12,14,15,17
Inventive step (IS)	Yes: Claims	-
	No: Claims	1-20
Industrial applicability (IA)	Yes: Claims	1-20
	No: Claims	-

2. Citations and explanations

see separate sheet

Re Item V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

- 1.a GB-A-1.285.551 (D1) discloses a method for forming a film on a planar surface wherein a granular layer is applied to the planar surface by using electrostatic forces and the granular layer is finished to form the film (cf claim 1 of D1). D1 appears to be novelty destroying (Art. 33(2) PCT) for the subject-matter of claim 1 of the present application.
- 1.b D1 also discloses the additional technical features of dependent claims 2-6:
claim 2: cf claim 8 of D1;
claim 3: cf page 2, lines 125-130;
claims 4-6: cf page 3, lines 10-24;
- No inventive step (Art. 33(3) PCT) can be seen in the step of peeling off the film layer from the substrate (cf present claim 10).
- In claim 2 it is not understood if the sheet-like substrate should be a web or what should be understood by "allowed to travel as a continuous web" (Art. 6 PCT).
- 1.c From the afore mentioned remarks it can also be deduced that D1 should be novelty destroying for the device defined in independent claim 11 and in dependent claims 14 and 15, considering their direct dependency on claim 11 (Art. 33(2) PCT).
- 1.d No inventive step can be seen in the method of claim 16. It should be obvious for a skilled person when rebuilding a converting line as defined in the preamble of claim 16 to take into consideration the device of D1 (Art. 33(3) PCT). Moreover, it appears to be more appropriate to direct the method of claim 16 to the use of the device defined in present claims 11-15 without repeating the features of said device (Art. 6 PCT - conciseness).
- 1.e The product obtained by process of D1 is a multilayered sheet-like product comprising a film layer wherein the film layer has been formed by applying a granular layer on the surface of the substrate (sheet of paper) by using

electrostatic forces and the granular layer has been finished to form the film (cf page 3, ll. 10-24). D1 seems to be novelty destroying for the product of claim 17 (Art. 33(2) PCT).

- 1.f No inventive step can be seen in claims 19 and 20 where only the desire to maintain the oxygen transmission rate or water vapour transmission rate below a certain threshold value is expressed (Art. 33(3) PCT).
2. US-A-4,296,142 (D2) also appears to be novelty destroying for the subject-matter of claims 1 to 7, 11, 12, 14, 17: see claim 1, figures 1 and 2, col. 5 (lines 40-43), col. 3 (lines 49-64). Moreover, as the product of D2 is thought for containing food, the additional technical features of claims 19 and 20 should be even more obvious than they are starting from D1 (Art. 33(3) EPC). It is also well-known in food industry to produce multi layered sheets including one metal layer (e.g. Tetrapak™) as is mentioned in present claim 18 (Art. 33(3) PCT).
3. US-A-5,731,043 (D3) is relevant for the present application in that it relates to a coating process wherein coating powder is electrostatically charged by means of a triboelectric process (see e.g. abstract). Hence, the additional technical features of dependent claims 8, 9 and 13 do not seem to involve an inventive step (Art. 33(3) PCT).

GB-A-1.328.238 (D4) discloses a process of manufacturing a paper strip coated on one face with an adhesive. The adhesive film is obtained by applying granular material with the help of an electrostatic field.

4. WO-A-02/45869 (D5) has been published on 13 June 2002 with a priority of 7 December 2000. Having been published after the priority date of the present application it can not be used in the PCT-Chapter-II-phase for acknowledging patentability. However, it could become relevant when entering the regional phases. In the European Regional phase it could be considered as a conflicting document under Art. 54(3) EPC. At first sight D5 seems to disclose many of the features of the present set of claims, especially of independent claims 1 and 11.

Further Remarks:

1. The product of claim 17 has been defined by process features. It does not seem that the skilled person, examining said product, would without any reasonable

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doubt be able to come to the conclusion that said product has been manufactured by means of the steps mentioned in claim 17. In other words, claim 17 is not clear (Art. 6 PCT), a product-by-process formulation does not seem to be allowable.

2. The additional technical features of claims 19 and 20 appear to be mere results to be achieved (Art. 6 PCT). A product should be defined by structural features which is not the case in present claims 19 and 20. Claims 19 and 20 should include the structural features that enable to obtain the named values of oxygen transmission rate and water vapour transmission rate.
3. The independent claims have not been drafted according to the requirements of Rule 6.3(b) PCT.
4. The most relevant of the above mentioned prior art documents should be discussed in the description (Rule 5.1(a)(ii) PCT).
5. The claims could be provided with reference signs according to Rule 6.2(b) PCT.